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10/055,995	01/28/2002	Eiji Toyoda	Q68272	2113

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 0521 0827
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claims 1 and 4, before the last word "cured" insert "--being--". In claims 2, 3 and 5 the phrase "supporting layer" is believed to be the "supporting base material", following standard rules of antecedent basis. In claim 6, line 3 the phrase "resist film image is present" is believed vague and indefinite with respect to the location of this film image.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7 and 8 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the presence of an upper temperature layer in

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claim 7 and an upper limit for the film thickness in claim 8 are each believed to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). More particularly, the upper limits in each of these two parameters should be set forth in the respective claims in order that the claims will not be unduly broad with respect to their disclosure

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

6. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Namikawa et al. Note particularly the disclosure at column 3 line 21 - column 4 line 32, column 4 line 57 - column 5 line 35, and Examples 1 and 2. With respect to the article claims, the reference uses essentially the same backing and coated adhesive layer as is taught in applicant's specification, as well as the various additives such as the "non-volatile compound" (applicant's "polymerizable compound" set forth at, e.g. specification page 8, lines 16+). With respect to process claim 6, the reference clearly shows utilizing the aforementioned adhesive tape to remove a resist film image from a suitable "article" on which the resist film is present by peeling off the adhesive tape in the resist film image together from the article. With respect to such parameters as the initial tensile modulus and flexural stiffness of the adhesive tape article claims 1-5, and the temperature claim of dependent claim 7 and thickness claim of dependent claim 8 with respect to the process, these are each believed to be either inherent properties of the reference since it utilizes the same elements and substantially the same process, or at most are believed to be obvious optimization properties for one of ordinary skill in the resist removable art from precision machine parts.

9. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Mizuno et al. -325 (Mizuno et al. -011 is cumulative) or EP 0971270A1. Note particularly Mizuno et al. -325, the Abstract, column 1 lines 11-15, column 2 lines 34-49, column 3 lines 6-38, column 4 line 53 - column 5 line 22, column 5 lines 32-34, column 5 line 51 - column 6 line 21, column 6 line 54 - column 7 line 24, column 7 lines 33-67, Examples 1 and 2; EP -270, column 1 lines 46-58, column 2 lines 15-21, column 4 line 9 - column 5 line 4, column 7 lines 10-38, Example 1-1. Each of the relied upon references is taken from substantially the identical art of the claimed invention, and appears to disclose adhesive tapes which, at least in certain embodiments utilize tape backings of the same materials (e.g. polyesters) as applicants contemplate, as well as the same range of thicknesses. Additionally, the adhesive compositions also appear to disclose the same type of pressure sensitive adhesives such as acrylics which further contain a non-volatile compound having at least one unsaturated double bond in the molecule and have a good affinity for the resist material to be removed (e.g. Mizuno et al. -325 Abstract). Accordingly, the various performance parameters set forth in the article claim are believed to either be inherent, or at most obvious optimizations for a tape having the same utility as that of the claimed invention. With respect to the method

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claims, the identical process as applicant contemplates is also taught, and such parameters as the peeling temperature (claim 7) and thickness of the resist film (claim 8) are each believed to be, if not inherently present, obvious modifications to one of ordinary skill, in the absence of unexpected results.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the Abstract of the Japanese Patent Laid-Open No. 1992-345015 cited in the specification.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

August 6, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1800-  
1700

*Daniel Zirker*